

REMARKS

Claims 1, 3, 4, 6, 8-10, 12, 14-28, and 34-45 are pending in the application, of which claims 14-16, 18-28, 30-33, and 35 are withdrawn as being directed to a non-elected invention. By this Amendment, claim 1 is amended. No new matter is added. Prompt and favorable consideration of these claims is respectfully requested.

I. Election/Restriction Requirement

Applicants acknowledge the election of Species 1, of which claims 13-21 read on, and claims 14-16, 18-28, 30-33, and 35 have been withdrawn by the Examiner as being directed to a non-elected invention. Applicants respectfully submit that at least claim 1 is generic, and thus, request **rejoinder** of non-elected claims, *viz.*, claims 14-16, 18-28, 30-33, and 35 if the elected claim 1 is allowed. (*See MPEP 821.04*)

Applicants respectfully reserve the right to file a divisional application(s) directed to the non-elected invention.

II. Claim Rejections: 35 U.S.C. § 102

Claims 1, 3, 4, 6, 8-10, 12, 17, 34, 36-39, and 41-42 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,876,749 ("Killion"). Applicants request reconsideration and withdrawal of the rejection of these claims for at least the following reasons.

Applicants respectfully submit that the Killion reference fails to disclose or suggest each and every element of claim 1, and therefore, an anticipatory rejection has not been established.¹

¹ A claim is anticipated only if each and every element as forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

For example, claim 1, as amended, recites, *inter alia*:

the one or more electrical controlling devices form part of the one or more sound inlet ports and can be operated by the user without affecting the configuration of the one or more sound inlet ports.

In particular, Applicants respectfully submit that the Killion reference fails to disclose or suggest, "the one or more electrical controlling devices can be operated by the user without affecting the configuration of the one or more sound inlet ports," as recited in amended claim 1.

In the outstanding Final Office Action, the Examiner contends that the actuator switch 10 of Killion corresponds to an "**electrical** controlling device."² However, Applicants respectfully submit that the switch 10 of Killion is not an electrical controlling device, but instead, a *mechanical* actuator switch 10. Switching between a directional mode and an omnidirectional mode in Killion is affected by sliding the actuator switch 10 between positions where a sound inlet tube 13 is covered and uncovered, respectively (see FIG. 1). In addition, the electrical contact 12 in Killion only "serves to indicate that the omni-directional position has been selected" (Killion, col. 3, lines 24-32). The switching, however, is done exclusively by moving mechanical parts to cover and uncover the inlet ports; no electrical parts are involved.

The Killion reference thus teach acoustical switches with purely mechanical parts that can be moved to cover and uncover acoustical ports and thereby modify acoustical paths that influence the acoustic performance of the respective devices. In contrast, Applicants' assembly includes an *electrical* controlling device that can be operated by a user for selectively controlling the operation of the assembly. *Electrical* controlling devices may include, for example, electrical switches that can be operated to control or change one or more *electrical* properties (such as electrical resistance or

² See Final Office Action, page 2, paragraph 2.

capacitance) between two or more electrical terminals (such as two wires). Acoustical switches, such as the physical controlling devices in *Killion* and *Darbut* change the acoustical properties between two or more acoustical ports; no electrical parts are involved.

Notwithstanding the above, Applicants have further amended claim 1 to recite that the "the one or more electrical controlling devices can be operated by the user without affecting the configuration of the one or more sound inlet ports," as recited in claim 1. In other words, the Killion device clearly discloses that the switch 10 can be operated by the user whereby sound inlet ports 7 and 13 change their configuration by being *covered and uncovered*. Therefore, since the switch 10 of Killion affect the configuration of the inlet ports 7 and 13, it fails to disclose or suggest all of the claimed features.

Therefore, contrary to the Examiner's contention, the Killion reference does not disclose or suggest each and every element of claim 1. Since the Killion reference fails to disclose each and every element of claim 1, it cannot provide a basis for a rejection under 35 U.S.C. § 102(e) and, thus, is allowable. Claims 3, 4, 6, 8-10, 12, 17, 34, 36-39, and 41-42 depend from amended claim 1 and, therefore, allowable for the similar reasons discussed above with respect to claim 1.

For at least these reasons, the Examiner is respectfully requested to reconsider and withdraw the § 102(e) rejection of claims 1, 3, 4, 6, 8-10, 12, 17, 34, 36-39, and 41-42.

III. Claim Rejections: 35 U.S.C. § 103

Claims 9, 12, 40 and 43-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Killion. Applicants respectfully traverse this rejection for the reasons discussed below.

Claims 9, 12, 40 and 43-45 are believed to be allowable for at least the reasons set forth above regarding claim 1. Since claims 9, 12, 40 and 43-45 are patentable at least by virtue of their dependency on independent claim 1, Applicants respectfully request that the rejection of claims 9, 12, 40 and 43-45 under 35 U.S.C. § 103(a) be withdrawn.

Claims 1, 3, 4, 6, 8-10, 12, 17, 34, and 36-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Darbut et al. ("Darbut"), U.S. Patent 6,597,793 in view of Killion. Applicants respectfully traverse this rejection for the reasons discussed below.

In order establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*³ noted that the rejection must establish a reasoning that it would have been obvious for one of ordinary skill in the art to have combined the teachings of the cited document(s). One way to establish this would be to show "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness" and "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does."⁴ In addition, the cited document(s), when

³ 550 U.S. at 398, 82 USPQ2d at 1396 (2007).

⁴ *Id.*

combined or modified, must teach or suggest all of the claim limitations of the rejected claims.⁵

Applicants respectfully submit that the proposed combination of references does not meet these criteria. In particular, the rejection fails to demonstrate that one of ordinary skill in the art would have combined the teachings of the Darbut and the Killion references in the manner used to reject the claims, and the applied references fail to teach and suggest *all* of the claim elements.

For example, in the outstanding Office Action, the rejection is based on an assertion that:

it would have been obvious to one skilled in the art to provide the controlling device or the switching mechanism (15) of Darbut being an electrical device, as taught by Killion et al. for better sensing the position of the actuator switch and selecting a microphone output base on the position sensed.⁶

Applicants respectfully submit, however, that the above statement is merely conclusory and is not an “explicit rational” as required by *KSR Int’l*. Therefore, because the Examiner has not provided an explicit analysis as required by *KSR Int’l*, a *prima facie* case of obviousness has not been established.

Even if *arguendo*, the teachings of the Darbut and the Killion references were to be combined, they would nonetheless fail to teach each and every element of the rejected claims. In particular, Applicants respectfully submit that the Darbut and the Killion references fail to teach or suggest, *inter alia*, “the one or more electrical controlling devices can be operated by the user without affecting the configuration of the one or more sound inlet ports,” as recited in amended claim 1.

The Darbut reference discloses a hearing aid construction 10 having a switch with “a mechanical switching mechanism 15” (Darbut, col. 2, line 38, and Fig. 1). The

⁵ *In re Vaeck*, 947, F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

⁶ See Final Office Action, mailed January 22, 2009, page 7, second full paragraph.

Darbut reference hearing aid construction 10 includes a directional microphone 26 having first and second acoustic ports 30 and 32 (Darbut, col. 2, lines 48-57, and Figs. 2 and 3). The mechanical switching mechanism 15 rotates relative to the microphone 26 between different positions to establish different acoustic paths and to thereby shift the microphone construction between a directional mode and an omnidirectional mode (Darbut, col. 4, lines 25-43). The switching is done exclusively by moving mechanical parts; no electrical parts are involved.

Therefore, because the proposed combination of the Darbut and the Killion references fails to teach or suggest *all* of the elements of claim 1, no *prima facie* case of obviousness has been established.

Since the rejection fails to provide a proper motivation to combine the Darbut and the Killion references, and since the proposed combination of references would, even if combined, fail to disclose or suggest each and every element of the rejected claims, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to 1, 3, 4, 6, 8-10, 12, 17, 34, and 36-45. Accordingly, Applicants respectfully request that the rejection of claims 1, 3, 4, 6, 8-10, 12, 17, 34, and 36-45 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

IV. Request for Interview

Applicants respectfully request, prior to the issuance of an action on the merits, that the Examiner grant a personal interview with Applicants' representative in order to discuss the Office Action, and the differences between the cited prior art and the subject matter cited in the claims.

Applicants' representative will telephone the Examiner in the near future in an attempt to schedule this personal interview. However, as Applicants' representative cannot anticipate when this action will be scheduled for further action by the

Examiner, it is requested that the Examiner contact Applicants' representative by telephone, at the number given below should a specific date for the interview have not been scheduled when the Examiner takes this action up for further action. Every effort will be made to meet the Examiner's scheduling preference.

V. Conclusion

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the telephone number of the undersigned below.

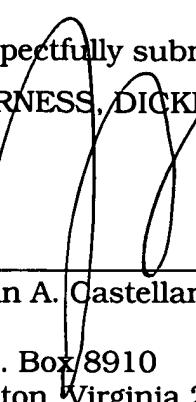
Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants hereby petition for a two (2) month extension of time for filing a reply to the outstanding Office Action and submit the required \$490 extension fee herewith.

Applicants hereby petition under the provisions of 37 C.F.R. § 1.136(a) for an extension of time in which to respond to the outstanding Office Action and include a fee as set forth in 37 C.F.R. § 1.17(a) with this response for such extension of time.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. **08-0750** for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
HARNESS, DICKEY, & PIERCE, P.L.C.

By

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